

## REMARKS

Reconsideration is respectfully requested.

## 35 USC §103

The Examiner has rejected Claims 1, 2, 9, and 20 under 35 USC §103, as allegedly being unpatentable over Lesniak (US 4,513,811) in view of Frei (US 4,117,884).

It is well settled that to support an obviousness rejection, the prior art must contain some teaching or suggestion to make the modifications suggested by the Examiner. In this regard, the Federal Circuit has stated that "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (emphasis added) *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992.) Applicant respectfully submits that no such suggestion exists in the Lesniak reference or the Frei reference to so modify or combine the elements to result in the Applicant's claimed invention as suggested by the Examiner.

The Examiner has stated "It would have been obvious in view of Frei to use the heat exchanger structure of Lesniak in combination with a dryer in order recover heat from the dryer exhaust..." Applicant respectfully disagrees and requests evidence from the Examiner showing motivation to combine the references as suggested by the Examiner.

The Federal Circuit has enunciated several guidelines in making a §103 obviousness determination. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)). (Emphasis added). Applicant respectfully submits that the Examiner has not provided evidence of teachings or motivation to combine the references as suggested by the Examiner and that therefore the Examiner has not made a prima facie case of obviousness. It is therefore respectfully submitted that rejection of Claims 1, 2, 9, and 20 (and all Claims dependent thereon) should be withdrawn.

It is noted that Applicant has amended Claim 1, Claim 2 and Claim 20 to even more clearly define Applicant's invention.

The Examiner has rejected Claims 3-6, and 10-19 under 35 USC §103, as allegedly being unpatentable over Lesniak (US 4,513,811) in view of Frei (US 4,117,884) and in further view of Skinner (1,618,485).

Applicant repeats in full at this point by reference the entire above argument regarding the Lesniak reference and Frei reference.

'Former Chief Judge Markey of the Federal Circuit has stated, "virtually all inventions are 'combinations', and ... every invention is formed of 'old elements' ... Only God works from nothing. Man must work with the elements." H.T. Markey, *Why Not the Statute?*, 65 J. Pat. Off. Soc'y 331, 333-34 (1983).

The Federal Circuit has stated: "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992.)

Applicant respectfully submits that the Examiner is apparently attempting to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Applicant respectfully submits that no such suggestion exists in the Lesniak reference, the Frei reference or the Skinner reference to so modify or combine the elements to result in the Applicant's claimed invention as suggested by the Examiner. Applicant respectfully submits that the Examiner has not shown any evidence of teachings or motivation to combine the references and has not made a *prima facie* case of obviousness for the elements of Claims 3-6, and 10-19. It is therefore respectfully submitted that rejection of Claims 3-6, and 10-19 (and all Claims dependent thereon) should be withdrawn.

It is noted that Applicant has amended Claim 3 to even more clearly define Applicant's invention:

Regarding Claim 4: Applicant has amended Claim 4. The prior art references do not teach at least five rows of substantially square heat transfer conduits with corners pointed in the direction of flow as Claimed by Applicant.

The Skinner reference teaches (column 1, lines 39-44, emphasis added):

"These radiator tubes are of **oblong** cross section, being shown as substantially **diamond** shaped..."

The primary definition of the word "oblong" according to Webster's Ninth New Collegiate Dictionary is (emphasis added) "**Deviating** from a square, circular, or spherical form by elongation in one dimension." Thus, the Skinner reference teaches away from square conduits, and it would not have been obvious to one of ordinary skill at the time the invention was made to combine the references as suggested by the Examiner. Applicant respectfully submits that the combination of references suggested by the Examiner is improperly based on impermissible hindsight. Applicant respectfully points out per MPEP § 2141 "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

Regarding Claim 14: Applicant respectfully submits that Claim 14 is not a product by process claim and that the Examiner's basis for rejection is therefore erroneous. The cited references do not teach the claim elements of Applicant's claim (for example, element "a" of Claim 14). The

Examiner has not established a prima facie case of obviousness for the elements. It is therefore respectfully submitted that rejection of Claims 14 (and all Claims dependent thereon) should be withdrawn.

The Examiner has rejected Claims 7-8 under 35 USC §103, as allegedly being unpatentable over Lesniak (US 4,513,811) in view of Frei (US 4,117,884) and in further view of Doty (US 33,528). Applicant repeats in full at this point by reference the entire above argument regarding the Lesniak reference and Frei reference. Claims 7 and 8 depend from Claim 1, which Applicant believes should be allowable.

Applicant believes that all Claims, as amended, are allowable with respect to 35 USC §103, and respectfully request that all such rejections be withdrawn.

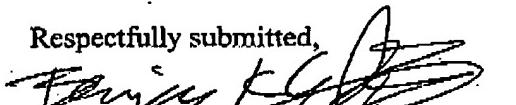
For the reasons given above, and after careful review of all the cited references, Applicant respectfully submits that none of the cited references nor any combination of the cited references will result in Applicant's claimed invention in the present Claims, as amended. But even if any such combination might arguably result in such claimed invention, it is submitted that such combination would be non-obvious and patentable.

In view of the above comments, all of the presently (amended and/or) pending Claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw any outstanding rejections of the Claims and to allow this application.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 50-1887.

Applicant respectfully requests that the Examiner, after having an opportunity to review this Office Action Response, grant a telephonic interview to Applicant's undersigned agent in order to discuss Applicant's response to the Examiner's first Office Action (before the Examiner prepares a second office action), to attempt to reach mutual understanding and clarify any outstanding issues. Applicant respectfully requests that the Examiner call Applicant's undersigned agent at 602-263-9200 to schedule a telephonic interview at least two business days in advance to allow the Applicant's undersigned agent time to prepare and schedule the interview. For telephonic scheduling purposes, Applicant's agent is located in Arizona, in the Mountain Standard Time zone.

Respectfully submitted,



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Date: August 12, 2005

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to the Patent and Trademark Office fax number (571)-273-8300 on August 12, 2005.

Date August 12, 2005

Signature:

Benjamin K. Erlick, Agent for Appl.